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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRINGTON HERMAN

Appeal 2008-0982
Application 10/727,446
Technology Center 3600

Decided: May 7, 2008

Before DEMETRA J. MILLS, ERIC GRIMES, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a method for promoting the growth of shoots from a log. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

BACKGROUND

“Alder, Beech and Birch are economically important tree species that are used to produce lumber and other wood products. ... One approach to propagating Alder, Beech and Birch trees that possess desirable characteristics is to clone these trees. Alder, Beech and Birch trees may be

cloned by excising portions of the trees that include meristematic tissue (e.g., buds or lenticels), and inducing the meristematic tissue to produce shoots, which may then be rooted and cultivated to produce mature trees” (Spec. 1).

DISCUSSION

1. CLAIMS

Claims 1-16 are pending and on appeal. Claims 1 and 7 are representative and read as follows:

Claim 1: A method for promoting the growth of shoots from a log, the method comprising the step of
applying a fertilizer solution, that comprises less than about 0.01% (w/v) nitrogen, to a member of the group consisting of an Alder log, a Beech log and a Birch log, in an amount sufficient to promote the growth of shoots from the log.

Claim 7: The method of Claim 1, wherein the fertilizer solution comprises potassium and phosphorus.

2. OBVIOUSNESS I

Claims 1-6 and 10-16 stand rejected under 35 U.S.C. § 103 as obvious in view of Radwan¹ and Saul.² The Examiner relies on Radwan as disclosing “a method for promoting growth of shoots ... comprising applying [to an alder] fertilizer solution (‘intermittent overhead mist’ ...) that comprises less than about 0.01% (w/v) nitrogen” (Ans. 4). The Examiner further finds that the “mist is water which would contain less than about 0.01% (w/v) nitrogen” (*id.*).

¹ Radwan et al., “Softwood cuttings for propagation of red alder,” 3 *New Forests*, 21-30 (1989).

² Saul et al., “Vegetative propagation of alder,” 33 *Forest Research Note*, 1-3 (1982).

The Examiner finds that Radwan does not disclose the use of an alder log. The Examiner relies on Saul as disclosing “the use of a log (‘cuttings’ ...) as a source for propagation” (*id.*). The Examiner concludes that it “would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Radwan ... by using a log as disclosed by Saul ... to have a practical way of propagating cuttings of alder with both shoots and roots ... to increase the developmental speed of improved genotypes” (*id.*).

Appellant argues the cited references fail to teach or suggest propagation of shoots from a log, in that “the term ‘log’ refers to a piece of cut timber” (App. Br. 10). Appellant cites a dictionary that defines a log as “a. A large section of a trunk or limb of a fallen or felled tree. b. A long thick section of trimmed unhewn timber” (*id.* at 10-11), and argues that the “term ‘log’ is used in the instant specification in a manner ... consistent with its ordinary meaning as a cut piece of timber” (*id.* at 11; citing the Spec. at pp. 2-3).

We agree with Appellant that the Examiner has not adequately explained how the references would have suggested promoting shoots from a “log” as required by the claims. “[A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

We agree with Appellant that the ordinary meaning of the term “log” refers to a piece of a tree that is substantial in size. The Specification does not provide an express definition of a “log,” but provides that “logs that are useful in the practice of the present invention are typically between twelve inches and twenty four inches long, typically have a diameter between one inch and two inches, and typically have a generally cylindrical shape” (Spec. 3, ll. 9-12). Thus, the term “log” is used in the Specification consistent with its ordinary meaning.

Given the ordinary meaning of the term “log,” we do not agree with the Examiner’s conclusion that the cited references would have suggested the use of logs to generate shoots, because both of the cited references describe relatively small plant cuttings of new growth plant areas (i.e., induced shoots or epicormic sprouts on living trees) and thus cannot be reasonably extrapolated to suggest a plant cutting of the size or age (i.e., age on the tree as indicated by the size) of a log.

Radwan discloses that “mature trees were girdled around half the circumference ... to encourage formation of epicormic sprouts, and the younger trees were heavily pruned to stimulate production of vigorous new shoots” (Radwan 23). Radwan discloses that the “[c]uttings made from the shoots were 10-12 cm long and 2-4 mm in diameter” and “[c]uttings made from the epicormic sprouts were 6-10 cm long and 2-3 mm in diameter” (*id.*). Saul discloses that “cuttings (10-16 cm long) were ... from epicormic branches and branch terminals” (Saul 1). Thus, the cuttings or excised tree portions in both Radwan and Saul were of a size and age that would not suggest a “log,” given its ordinary meaning. *See also* App. Br. 10-12

(distinguishing “logs” from the tree sources utilized in Radwan and Saul). Thus, we agree with Appellant that the Examiner has not adequately shown that the cited references would have suggested to one of ordinary skill in the art of a method of using “an Alder log, a Beech log and a Birch log” as a source for shoots.

We also agree with Appellant that Radwan does not suggest using “a fertilizer solution, that comprises less than about 0.01% (w/v) nitrogen . . . to promote the growth of shoots from the log” as recited in claim 1. The Examiner has not provided an adequate basis on which to conclude that the “overhead mist” of water used by Radwan would be understood to be a fertilizer by persons of ordinary skill in the art (*see* App. Br. 13). Thus we agree with Appellant that misting with water – even though it contains less than 0.01% nitrogen – does not meet the limitation requiring “fertilizer.” Furthermore, as noted by Appellant, Radwan discloses producing shoots from living trees by applying two kilograms of a 10-20-20 fertilizer directly to a planted tree (Radwan 23), which would appear to exceed the 0.01% nitrogen limitation (Radwan 23; App. Br. 13-14). The Examiner has not provided an adequate basis for concluding that Radwan would have suggested applying a fertilizer solution containing the limited amount of nitrogen recited in the claims.

We therefore agree with Appellant that the Examiner has not made out a *prima facie* case of obviousness based on the cited references, and the rejection of claims 1-6 and 10-16 under 35 U.S.C. § 103 as obvious in view of Radwan and Saul is reversed.

3. OBVIOUSNESS II

Claims 7-9 stand rejected under 35 U.S.C. § 103 as obvious in view of Radwan, Saul and Huss-Danell.³ The Examiner relies on Radwan and Saul for the disclosures set forth above, and relies on Huss-Danell as disclosing “a rooting fertilizer for alder with K, P, and Cu” (Ans. 6).

Appellant argues that claim 7 depends from claim 1 and that the “deficiencies of Radwan ... and Saul ... are not cured by the teachings of Huss-Danell” (App. Br. 15).

We agree with Appellant that the Examiner has not made out a prima facie case of obviousness based on the cited references. The disclosures of Radwan and Saul are discussed above. Huss-Danell discloses the “rooting of softwood cuttings of *Alnus incana*” (Huss-Danell, abstract), with cuttings obtained by repeatedly pruning stock plants at 5-week intervals, and with only shoots that had emerged during the five weeks being used as “[a]ppical parts, c. 8 cm long, or one-leaf internode cuttings, or leaves only” in the rooting process (Huss-Danell at 113). Thus, the cuttings of Huss-Danell in terms of size and age on the tree would also not be considered “logs,” according to the ordinary meaning of the word.

We agree with Appellant that the Examiner has not adequately shown that the cited references would have suggested to one of ordinary skill in the art the claim limitation of “an Alder log, a Beech log and a Birch log” as a source for shoots.

We therefore agree with Appellant that the Examiner has not made out a prima facie case of obviousness based on the cited references, and the

³ Huss-Danell et al., “Conditions for rooting of leafy cuttings of *Alnus incana*,” 49 *Physiol. Plant*, 113-116 (1980).

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rejection of claims 7-9 under 35 U.S.C. § 103 as obvious in view of Radwan,
Saul and Huss-Danell is reversed.

REVERSED

saj

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